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09/690,289	10/16/2000	Lawrence McAllister	10407/459	2190

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EXAMINER	
ENATSKY, AARON L	
ART UNIT	**PAPER NUMBER**
3713	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/690,289	Applicant(s) MCALLISTER ET AL.	
	Examiner Aaron L Enatsky	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-87* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-87* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 October 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of a request for an extension of time and an amendment on 10/24/03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3-5, 24-26, 45-47, 66-68 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant has claimed a human being, claimed as "a user", which is restricted from patentability by statutory bar.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign countly or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, 13-20, 22-23, *25-26,* 34-44, 46-47, 55-62, 64-65, 67-68, 76-83, and 85 are rejected under 35 U. S.C. 102(b) as being anticipated by GB Patent No. 2,251,112 to Marchini et al. ("Marchini"). Marchini teaches a gaming machine that includes a touch-screen device for controlling, in conjunction with a computer, a game including a slot machine game

(Abstract). Marchini also teaches that the touch screen comprises a transparent screen or window through which the symbols can be displayed, where the symbols can be displayed using either a mechanical reel display or a video screen (2:20-3:12). Furthermore, Marchini includes a plurality of different types of touch type input sensors maybe used including touch, pressure, and proximity sensitivity.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner m which the invention was made.

Claims 3, 24, 45, 66, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchini as applied to claims 1-2, 4-5, 13-20, 22-23, 25-26, 34-44, 46-47, 55-62, 64-65, 67-68, 76-83, and 85 above, and further in view of Nolte et al. '070 (Hereafter, Nol). Marchini teaches the above-discussed limitations, but does not teach of a user selectively stopping the spinning reels. Nol teaches a video slot game machine having a user ability to selectively stop individual slot reels (2:33-37). Nol also teaches that video slot games are known to ordinary skill in the art (1:11-13). As both Marchini and Nol both teach games dealing with slot machines, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marchini to include the user selectable stopping of the reels by Nol, to add a sense of operator skill (Nol 1:29-31) to the chance element nature of the slot game.

Claims 4, 34-41, 46, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchini as applied to claims 1-2, 4-5, 13-20, 22-23, 25-26, 34-44, 46-47, 55-62, 64-65, 67-

68, 76-83, and 85 above, and further in view of Bertram et al. (Hereafter, Bert). Marchini teaches the claimed limitations as discussed above, but does not specifically disclose the composition of the touch-screen employed in the gaming machine. Bert teaches of a touch screen to reduce noise and cost (Abstract), applied in a variety of environments including a gaming on a slot machine (2:10-14). Bert also teaches that the touch-screen uses a composite material such as glass in a CRT (2:1-5), a metallic material (4:1-9), a polymeric material (3:2-6), and a plurality of transducers (4:1-9 and 4:57-64). One would be motivated to combine both Marchini and Bert as they both teach a touch-screen device used in a gaming machine dealing with a slot machine. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marchini, which does not specify a type of touch-screen, to include the touch-screen specifications by Bert to reduce ambient noise and cost. Additionally, although Marchini does not disclose a specific touch-screen, it is further old and well known in the art that various touch-screen devices can be employed interchangeably, therefore merely a design choice as to what touch-screen to employ.

In re claims 12, 54, and 75, Marchini in view of Bert teaches the claimed limitations as discussed above, but does not specifically teach the use of a bezel to protect the transducers. However, Marchini in view of Bert does teach that the electrodes/transducers are located substantially near the exterior edge of a screen, and it is well known that screen have bezels protecting the outer edge of a screen, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to protect the electrodes/transducers by providing covering with the bezel, leaving exposed only necessary components to distinguish a user's touch.

Claims 21, 63, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchini as applied to claims 1-2, 4-5, 13-20, 22-23, 25-26, 34-44, 46-47, 55-62, 64-65, 67-68, 76-83, and 85 above, and further in view of Wiltshire et al. '602 (Hereafter, Wilt). Marchini teaches the claimed limitations as discussed above, but does not teach of using a plurality of touch panel terminals. Wilt teaches using multiple gaming terminals in a network environment (Fig. 1D) that can play reel type games (Fig. 5A) utilizing touch-screen using inputs and can interchangeably use a mechanical reel system or combine with an electronic reel system (4:4-29). As Marchini and Wilt deal with mechanical and video slot machines using touch-screen controls, one would be motivated to combine Marchini with Wilt. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Marchini with a networked multitude of touch-screen games to increase game availability and help reduce total system cost (Wilt, Abstract).

Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchini as applied to claims 1-2, 4-5, 13-20, 22-23, 25-26, 34-44, 46-47, 55-62, 64-65, 67-68, 76-83, and 85 above, and further in view of Franchi '533. Marchini teaches the above-discussed limitations, but does not teach of a user order services from using the game machine. Franchi teaches a networked casino communication system for all gaming machines and tables, to provide additional security to machines that provide good or services to users (1:1-2:11). Franchi also teaches that a machine may provide goods or services to a user after receiving appropriate instructions from a user, wherein the machine receiving these instructions can be slot machines with touchscreens (7:55-44). One would be motivated to modify Marchini to include the system that allows service to be selected by users so that additional comfort can be provided to users of

game machines, resulting in longer game play. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marchini to use the system taught by Franchi so that users can be provided with more features that will make them more comfortable, thus increasing game play time and casino profit.

Response to Arguments

Applicant's arguments with respect to claims 1-86 have been considered but are not persuasive. Applicant has amended independent claims and adds new claims 85-87. Applicant also provided arguments to support Applicant's position that the Marchini reference does not teach the instant invention.

Examiner believes that Applicant's remarks can be summarized as such: Applicant believes that Marchini does not provide an enabling disclosure of a game machine that supports touch-screen controls that can be used to manipulate mechanical reels and that the technology to provide touch screen control of mechanical reels did not exist until 10 years after the Marchini reference published. Applicant has also added claim language in attempts to further distinguish touch screen control functions.

Examiner disagrees with Applicant's position that Marchini does not clearly teach mechanical reels controlled by a touch screen mechanism. Examiner points Applicant to Marchini 2:20-23 "Most preferably, the touch screen comprises a screen or *window* on or through which symbols are displayed." Marchini first details that a touch screen can be used on a window. Secondly, at Marchini 3:5-8, "The screen may be a video screen (whether crt or lcd), or maybe a window. Thus for example... or the *screen maybe a window through which actual rotating reels can be seen.*" For emphasis, Examiner has highlighted the portion that describes a

window for showing actual rotating reels. As previously noted, Marchini references a touch screen that can comprise a window, which has now been further clarified as a window is that shows actual rotating reels device. The "actual rotating reels" being distinct from reels shown on a CRT or LCD. Finally, at Marchini 3:9-12, "The touch-sensitive controls may be *used for any or all of the machine operations.*" In the case of a window with actual rotating reels, "*any or all*" would mean the touch screen device was meant to control the actual rotating reels. As such, Examiner believes that the rejection detailed above, is proper.

In regard to Applicant's remarks on the Citation of Pertinent Prior Art, the comments have been considered, but are not considered persuasive nor currently relevant to the standing rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ALE
1/16/04

MICHAEL O'NEILL
PRIMARY EXAMINER